

REMARKS

In the Final Office Action (“Office Action”) of April 21, 2005, claims 1, 2, 4, 10-12, 16, 18, 28 and 61-98 were rejected. Applicants hereby respond to the Office Action based on the following remarks.

Also in the Office Action, the Examiner stated he was unable to find two references in the March 25, 2005 IDS. Applicants have submitted the two references with this response.

First Rejection under 35 U.S.C. § 103(a)

On page 2 of the Office Action, the Examiner rejected claims 1, 2, 4, 10-12, 16, 18, 61-70 and 77-98, of which claims 1, 86, 87, and 90 are independent, under 35 U.S.C. 103(a) as being unpatentable over Silverman in view of Schott. Applicants traverse these rejections and respectfully request reconsideration.

Applicants first address claim 1, which is directed towards aspects of the present invention related to facilitating the placement of a trade order for an item and for displaying transactional information to a user regarding the buying and selling of items in a system. Presenting information according to the method of claim 1 allows users to intuitively place an order and view trends in the bids and offers in addition to the buying and selling of the item being traded. Further, an order indicator associated with an order icon can be moved to allow precise placement at the desired value. Independent claims 86 and 90 have limitations that mirror the limitations found in claim 1 and are patentable for similar reasons as claim 1.

The test under 35 U.S.C. 103(a) is whether the claimed invention as a whole is taught by the prior art. As described below, Silverman lacks many limitations found in Applicants’ claim 1 and Schott fails to overcome the deficiencies of Silverman.

On page 3 of the Office Action, the Examiner admits that Silverman “does not specifically disclose the limitations of positioning of indicators along a scaled axis of values corresponding to an associated value or, in response to a user initiated command, moving an indicator (icon) to a location on the axis.” Applicants agree with the Examiner on this point. Indeed, Silverman is missing so many limitations found in

Applicants' claim 1 – i.e., limitations from every step of claim 1 – that a large void must yet be filled to find Applicants' claim 1 obvious under 35 U.S.C. 103(a). Schott does not fill that void as further explained below. Thus, even if combined, the references do not teach or suggest Applicants' claimed invention.

Claim 1 calls for “displaying a plurality of bid indicators, each corresponding to at least one bid for a quantity of the item, each bid indicator at a location along a first scaled axis of values corresponding to a value associated with the at least one bid,” – on page 3 of the Office Action, the Examiner admits that Silverman does not show “positioning of indicators along a scaled axis of values corresponding to an associated value.”

Applicants agree. Silverman does not show this limitation, and therefore could not allow a user to intuitively place an order and view trends in the bids of the item being traded.

Claim 1 also calls for “displaying a plurality of offer indicators, each corresponding to at least one offer for a quantity of the item, each offer indicator at a location along the first scaled axis of values corresponding to a value associated with the at least one offer,” – similarly, on page 3 of the Office Action, the Examiner admits that Silverman does not show “positioning of indicators along a scaled axis of values corresponding to an associated value.” Applicants agree. Silverman does not show this limitation, and therefore could not allow a user to intuitively place an order and view trends in the offers of the item being traded.

Claim 1 also calls for “displaying an order icon associated with an order by the user for a particular quantity of the item,” – Silverman does not show order icons and does not teach displaying an order icon associated with an order by the user, and therefore could not enable movement of an order indicator associated with an order icon to allow precise placement at the desired value.

Claim 1 also calls for “in response to a user initiated command, moving the order icon to a location associated with a value along the first scaled axis of values,” – on page 3 of the Office Action, the Examiner admits that Silverman does not show “in response to a user initiated command, moving an indicator (icon) to a location on the axis.” Applicants agree. Silverman does not show this limitation, and therefore could not

enable movement of an order indicator associated with an order icon to allow precise placement at the desired value.

On page 3 of the Office Action, the Examiner states that “Schott discloses these features [the features missing in Silverman] at Fig. 19a (scaled axis) and movement of an indicator to a location on the axis in response to a user initiated command at Col. 3, lines 20-25 and Col. 20, line 60 to Col. 21, line 28.” Applicants wish to note that Fig. 19a shows simply a dynamic bar graph. The text in Schott, referred to by the Examiner on page 3, describes that when one changes a feature of the bar graph, the associated data tables (in a spreadsheet) are reconfigured to correspond to the bar change. So, Schott teaches dynamic graphs wherein the computer user is able to manipulate the graph shape directly, which in turn not only modifies the graph, but also alters the corresponding and underlying tabularized data. The “financial information” that the Examiner refers to in Figs. 26A-26F is a training budget for a New York Office (35% of the budget), Western Region (30%), and International (35%). A dynamic pie chart is also shown in the figures and when the pie chart is changed, then the corresponding budget percentages in the spreadsheet change accordingly.

Like Silverman, Schott is missing the limitations of claim 1. Neither reference displays bid/offer indicators along a scaled axis of values – the indicators corresponding to bids and offers for an item. Neither reference shows displaying an order icon associated with a user’s order for a particular quantity of the item. Neither reference shows moving the order icon to a location associated with a value. The Examiner cannot show otherwise, and therefore, not every limitation of claim 1 is found in the prior art, which is required to make an obvious showing under 103.

To find a rejection under 103, the Examiner makes a giant leap by combining Schott and Silverman to conclude on page 3 of the Office Action that it would have been obvious to modify the references because this would have allowed “dynamic creation of orders, reconfiguration of the graphical representations according to manipulation of the graph and simple and easy modification of underlying order data.” The Examiner further states that “[s]uch capacity would allow users to readily perceive the status of a market and participate in the market efficiently through quick manipulation of their particular

order information (icon).” Yet, to combine the references under 35 U.S.C. 103 there must be some suggestion or motivation to modify or combine the reference teachings. MPEP 2143. However, no suggestion or motivation exists in the references and even the Examiner has so admitted on page 13 of the Office Action.

On page 13, referring to claim 1, the Examiner admits that in this case the motivation to combine was “independently derived.” The Examiner provided no evidentiary evidence to support this independent derivation. According to MPEP 2144.03(A), when the Examiner relies on common knowledge, it would not be appropriate for the Examiner to take notice of facts without citing a prior art reference where the facts asserted to be well-known are not capable of instant and unquestionable demonstration as being well-known. It is never appropriate to rely solely on common knowledge in the art without prior evidentiary support in the record, as the principal evidence upon which a rejection was based. (The Board cannot simply reach conclusions based on its own understanding or experience or on its assessment of its basic knowledge or common sense. Rather the Board must point to some concrete evidence in support of these findings.) Zurko, 258 F.3d at 1385.

Without more, the Examiner’s “independently derived” motivation is not enough. Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination or modification. The Examiner already noted on page 3 of the Office Action that Silverman does not show displaying bid and offer indicators along a scaled axis, or in response to a user initiated command, moving an icon associated with an order on the axis. Not only did Silverman not show those limitations, but there was no suggestion or desire to modify Silverman to have them. In fact, this proposed modification would change the principle operation of Silverman because the keystation book in Fig. 5, for example, is only a copy of the host book in Fig. 4, and the keystation book gets updated periodically over a network only by the host book. In fact, the keystation book illustrated in Silverman’s Fig. 5 displays only the aggregate primary quantities at each price rather than individual orders. (e.g., a primary quantity of “9” at “139.19” in Fig. 5 compared to two separate quantity entries of “6” and “3” at “139.19 in Fig. 4). Thus, since the user only sees aggregate quantities, there would be no way for a

user to modify individual orders using the keystation book. In other words, Silverman could not support the Examiner's proposal. Therefore, a user could not move the user's order as called for by Applicants' claim 1. According to MPEP 2143.01, the proposed modification cannot change the principle operation of a reference, otherwise the teachings of the references are not sufficient to render the claims obvious. In re Ratti, 270 F.2d 810. Here, the Examiner's proposed modification changes the principle operation of Silverman, and therefore, for at least this reason, the proposed modification cannot render claim 1 obvious.

Based on the cited prior art, the only way one could conceivably "modify" such references to result in Applicants' claimed invention would be if Applicants specification was used as a guide. Only with the knowledge of what Applicant's specification teaches and the advantages that are set forth, would one pick and choose and combine/modify the references in a way to attempt to achieve the claimed invention.

Second Rejection under 35 U.S.C. § 103(a)

On page 8 of the Office Action, the Examiner rejected claim 28 under 35 U.S.C. 103(a) as being unpatentable over Silverman in view of Schott and further in view of Sacerdoti et al. Claim 28 depends on claim 1, and adds further limitations to independent claim 1. Claim 28 recites, among other steps, "displaying a plurality of order tokens having different values," and "moving the order token to a user specified location with respect to the first scaled axis of values which corresponds to the desired value, thereby enabling placing of the order in accordance with the desired value." Neither Silverman nor Schott, alone or in combination, discloses a method of displaying a plurality of order tokens being moved with respect to an axis. Sacerdoti fails to overcome deficiencies of Silverman and Schott. Sacerdoti describes a 3-dimensional graphics generation and display application that can provide visual display of information retrieved from a database. (Abstract). Sacerdoti fails to disclose, teach, or suggest displaying order tokens or icons, or placing of the order in accordance with the desired value, as claimed in claim 28. Accordingly, Applicants respectfully submit that Silverman, Schott, alone or

in combination with Sacerdoti, does not render claim 28 obvious. Thus, claim 28 is in condition for allowance.

Additionally, claim 28 is allowable as it depends from claim 1, which is allowable for at least the reasons stated herein.

Third Rejection under 35 U.S.C. § 103(a)

On page 9 of the Office Action, the Examiner rejected claims 71-76 under 35 U.S.C. 103(a) as being unpatentable over Silverman in view of Schott and further in view of Harrington. Claims 71-76 depend on claim 1 and add further limitations to independent claim 1. The arguments related to the patentability of claim 1 are incorporated herein by reference from the First Rejection section above. Applicants agree with the Examiner that Silverman does not disclose a derivative of price. (See page 9 of the Office Action). As described in section of Harrington highlighted by the Examiner, having a user enter “a coupon for each maturity and an aggregate purchase price, and at the Issuer’s option, a price or yield for each maturity,” does not expressly or impliedly teach or suggest displaying indicators corresponding to a derivative of price along a scaled axis. Thus, Harrington does not overcome deficiencies of Silverman or Schott, alone or in combinations, as described in the First Rejection section above, and claims 71-76 are also in condition for allowance.

Independent claim 87 also discloses a derivative of prices. More specifically, claim 87 is directed to a method for displaying transactional information, comprising a plurality of bid indicators and a plurality of ask indicators being displayed at locations corresponding to values along a scaled axis such that the values represent a derivative of price for the item. The Examiner rejected claim 87 over Silverman in view of Schott. Applicants agree with the Examiner that Silverman does not disclose a derivative of price. Arguments related to patentability of Claim 1 from the First Section Rejections are incorporated herein by reference and are equally applicable with respect to the rejection of claim 87. Neither Silverman, nor Harrington, alone or in combination, as described in the previous paragraph, describes or suggests displaying indicators at locations

corresponding to values representing a derivative of price. Thus, claim 87 is in condition for allowance.

Additional comments

The Applicants would like to clear up a few statements made by the Examiner in this Office Action with respect to Applicants' previous response (response to office action mailed September 15, 2004).

On page 11 of this Office Action, the Examiner mischaracterizes statements made in Applicants' previous response by stating that the "Applicant asserts that neither Silverman nor Schott discloses 'facilitating the placement of an order for an item and for displaying transactional information to a user regarding the buying and selling of items in a system.'" The Examiner then cited to various sections in Silverman to conclude that Silverman shows the elements in the preamble of Applicants' claim 1. In making this statement, the Examiner further states that Applicants provide no suggestion of why these citations are deficient. While Silverman may or may not show elements of the preamble of claim 1, that is not what Applicants stated, nor would that be the test for patentability. Instead, on page 10 of the previous response, Applicants said claim 1 is a method for "facilitating the placement..." (which is reciting Applicants' claim 1 preamble) and that neither Silverman nor Schott show such *methods* (e.g., the *method* of claim 1). The Applicants' analysis started in the following paragraphs as to why the references do not show such a method covered by claim 1.

On page 12, the Examiner said that Applicants cite no claimed feature that distinguishes over Silverman. While the Applicants have cited claimed features that distinguishes over Silverman, it is worth noting that the Examiner has already stated many limitations that Silverman is missing and the Applicants agreed.

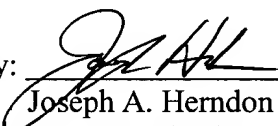
On page 13, the Examiner was mistaken that the Applicants suggest that the unobvious aspect of his invention is the use of a "dragging" technique for manipulating orders. While that may be part of the unobvious aspect, it is irrelevant as the Examiner must look at the claimed invention as a whole to determine nonobviousness.

Conclusion

For at least the foregoing reasons, independent claims 1, 86, 87 and 90 are allowable, and the remaining rejected claims depend either directly or indirectly from one of the independent claim. Applicants therefore submit that the present application is in condition for allowance and notice to that effect is hereby requested. If the Examiner believes that further dialog would expedite consideration of the application, he is invited to contact Mark Triplett at (312) 476-1151 or the undersigned attorney/agent.

Respectfully submitted,

Date: 6/21/05

By: 
Joseph A. Herndon
Reg. No. 50,469